



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,595	11/21/2000	Dan Kikinis	P1541D1	5336

33448 7590 01/12/2004

ROBERT J. DEPKE LEWIS T. STEADMAN
HOLLAND & KNIGHT LLC
131 SOUTH DEARBORN
30TH FLOOR
CHICAGO, IL 60603

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 01/12/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,595

Applicant(s)

KIKINIS, DAN

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Amendment filed 11/24/03, claims 16-33 remain pending and are hereby set forth for examination.
2. Claims 16 and 25 recite the limitation "said programming information" on the 6th and 8th line of the claims respectively. There is insufficient antecedent basis for this limitation in the claim (see MPEP 2173.05(e)).

Claim Rejections - 35 USC § 103

3. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.
4. Claims 16-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin, et. al. (Broadwin) U.S. Patent No. 5,929,850 in view of Eyer U.S. Patent No. 5,982,445.

Regarding claim 16, Broadwin teach a system for providing programming information, including a set top box, comprising;

a broadband receiver (140) to receive the displayable data stream (col 6/lines 50-60);

displayable indicia are pre-associated with commands (col 6/lines 18-23, 32-44) at a head end (100) (col 5/lines 21-36, selection options/thumbnails, col 9/lines 27-63, link data, col 6/lines 40-44) and provided as a part of the programming information in a displayable data stream (col 6/lines 18-23, 32-44)

circuitry to select the programming information, including the displayable indicia, and to cause it to be displayed (col 5/lines 64-col 6/lines 8);

a memory (col 7/lines 13-34) for storing (col 2/lines 64-66) programming information including displayable indicia (col 6/lines 53-60) continuously received (col 9/lines 1-8, col 6/lines 28-31), wherein said memory is repeatedly updated by said programming information including displayable data stream (steps 446 and 448 of Fig. 8);

user-operable apparatus (152) to select the displayable indicia (col 7/lines 52-63, col 9/lines 15-26);

wherein, in response to selecting the displayable indicia, the command associated with the selected displayable indicia is executed (col 11/lines 6-26, col 7/lines 58-63, col 8/line 5-12, col 10/line 4-17, 58-63);

however prior does not teach where the programming information is particularly future programming information;

Eyer teaches display data (displayable indicia) are pre-associated with commands at a service provider 100 (col 7/lines 59-col 8/line 19) and provided to head end (160) as a transport stream for distribution to the set top boxes (col 8/lines 20-38), display data is provided as a part of the program guide with program scheduling information (future programming information) in a displayable data stream, (col 4/lines 20-col 5/line 10);

a memory (col 8/lines 39-64 and col 9/lines 14-30) to store programming information (col 8/lines 39-64), wherein said memory is repeatedly updated by said displayable data stream (updated repeatedly see col 11/lines 1-12, or updated upon demand col 9/lines 5-13 col 10/lines 6-11, 21-26 or updated in real-time see col 10/lines 49-59).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to utilize Eyer's teaching where displayable indicia are pre-associated with commands at a service provider system and provided as part of the future programming information in a displayable data stream to the set-top box, as taught by Eyer, motivation would include with the audiovisual content other audiovisual programming that is normally seen on television utilizing the commands associated with the audiovisual content to commands for controlling television and non-television appliance functions along with commands for purchasing over the Internet, as taught by Eyer.

Regarding claim 17, wherein execution of the command comprises switching the display to a channel associated with the future programming (Eyer: switching channels, abstract, program guide schedule information col 4/lines 47-50, selection of particular programming service channel, col 4/lines 66-col 5/line 10).

Regarding claim 18, wherein a portion of the information received comprises WEB pages in a Markup Language (Eyer: abstract, col 5/lines 13-26).

Regarding claim 19, wherein the broadband receiver comprises a satellite data link adapted to download a satellite broadcasted data stream, and the information is received via the satellite data link (Eyer: Fig. 1, col 8/line 13-17, 30-32, 39-44).

Regarding 20, wherein a portion of the information received by satellite data link comprises Markup Language (110) (Eyer: Fig. 1, col 8/lines 39-52).

Regarding claim 21, wherein the future programming information is received along with television programming (Eyer: col 4/lines 20-col 5/line 10).

Regarding claim 22, a memory system (cache) wherein the future programming information including the command and displayable indicia associated with the command is stored (Broadwin: col 8/lines 53-56)

Regarding claim 23, wherein the broadband receiver (Eyer: col 5/lines 13-26) further comprises a satellite data link adapted to download a satellite broadcast data stream (Eyer: col 8/lines 20-38), and a land-based modem (324) (Broadwin: col 7/lines 64-col 8/line 3), and the future programming information is received by one or both of the satellite data link and the land based modem (Eyer: Fig. 1, col 8/lines 39-52, Eyer: col 4/lines 20-col 5/line 10).

Regarding claim 24, a user-operable WEB browser for browsing for Web-based information. (Eyer: col 9/lines 16-18).

Regarding claim 25, this claim comprises the method including features comprised in a set-top box discussed in claim 16, same rationale of rejection is applicable for the method claims.

Regarding claims 26-33 these claims are substantially the same as claims 17-24, respectively, same rationale of rejection is applicable.

5. Claims 16 and 25 may also be rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et. al. (Harper) U.S. Patent No. 5,585,858 in view of Coleman et. al. (Coleman) U.S. Patent No. 5,844,620.

Regarding claim 16, Harper teaches a set-top box (600 of Fig. 3), (col 6/lines 40-41, col 3/lines 66-col 4/line 5), comprising;

receiver coupled to a broadband bandwidth channel for receiving digital/analog data, e.g. conventional television broadcast signals (i.e. a broadband receiver) (col 3/lines 44-col 4/line 5, col 6/lines 28-41);

receiving by said receiver displayable data stream (col 3/line 43-46, 52-65),

displayable data stream e.g. video and graphics signal from a head end, (col 6/lines 16-25, 31-35, col 9/lines 6-21) including command(s) associated with a displayable indicia (col 8/lines 19-26, col 7/lines 19-22, commands, col 19/lines 15-21, commands associated with displayable indicia, col 8/lines 1-14, 19-26, 34-42, col 9/lines 14-19);

circuitry (616 of Figs. 3 and 7, col 5/lines 6-11) for selecting in the displayable indicia stream (col 12/lines 17-34, displayable data stream col 5/lines 67-col 6/line 9) and to form displayable data stream (col 12/lines 17-34, col 18/lines 39-42), the display including the displayable indicia (col 17/lines 51-59);

user-operable apparatus (604 of Fig. 1, col 6/lines 41-42) to select the displayable indicia (col 6/lines 49-col 7/line 6);

in response to selecting the displayable indicia, the command associated with the selected indicia is executed (col 18/line 59-col 19/line 6), in response to a selection of displayable indicia associated with a command is execution (col 7/line 65-col 8/lines 1-14); however Harper does not explicitly teach where displayable data stream including a displayable data stream which further includes future programming is received;

Coleman teaches receiving in real time video data including displayable data stream including future programming (video and graphic blended in received stream, col 2/line 45-55),

data stream including "demand data stream" further including future programming (i.e. schedule guide) is received, (col 4/lines 60-col 5/line 3), received (32), demultiplexed (34) and displayed (54) (col 13/lines 37-48, 62-col 14/line 4, 19-22, rendered i.e. cause it to be displayed, col 7/lines 2-14) program guide is acquired and displayed caused it to be displayed in real time, (col 6/lines 39-59 and col 7/lines 2-14 retrieved and displayed immediately);

displayable data stream information including displayable indicia associated with commands (col 3/lines 36-42, col 15/lines 32-42);

a memory to store said programming information, where said memory is repeatedly updated by said displayable data stream (storing e.g. in a RAM programming information repeatedly updated see col 1/lines 28-32, 56-col 2/line 11, repeatedly updated in real time col 4/lines 48-col 5/line 3).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include displayable data stream received in real time including displayable data stream further including future programming, motivation would be to further enhance Harper's composite interactive programming including future graphics message selection and associated commands broadcast as data codes embedded in the conventional video signal may be created to be include in other broadcast programs, as suggested by Harper.

Regarding claim 25, comprises the method for commanding the set-top box apparatus claimed on claims 16 and/or 34 rejected for obviousness under U.S.C. 103, this same rationale is also applied to method claims.

Response to arguments

6. Applicant argues prior art does not teach or suggest claimed invention, specifically, the Broadwin reference does not teach “automatic television control changes”, nor does it teach “where the selection within the program guide may be used to control various television functions”, because the reference according to applicant, merely discloses the selection of an image for display.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “automatic television control changes, wherein the selection within the program guide are used to control various television functions”) are within the scope of the claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The features applicant relies on, do not overcome the prior art of record.

7. Applicant argues prior art of record does not teach or suggest claimed invention, specifically, the Eyer reference does not teach a receiver that received a multimedia data stream that is intentionally and repetitively scanned and broadcast, therefore the reference does not teach where the program information is continually and automatically updated.

In response to the above argument, it is noted that according to applicant's specification database stored web content which is scanned in a repetitive operation such as continuously or in other be periodic and repetitively depending on specific system requirement is know in the prior art (page 6, lines 24- page 7, line 8). Repeatedly updating programming information including displayable indicia in a displayable data stream is taught by the prior art of record as noted above and further below.

8. Applicant argues prior art does not teach claimed invention, specifically, the Coleman reference does not teach repeatedly updating programming information stored in memory, because the reference discloses transmitting programming information in different packet streams.

In response to the above argument, applicant's interpretation of the prior art is noted, however, Coleman discloses as prior art a memory for storing said programming information, where said memory

is repeatedly updated by said displayable data stream (see col 1/lines 28-32, 56-col 2/line 11, repeatedly updated in real time data stream col 4/lines 48-col 5/line 3).

9. Applicant's argument filed 11/24/03 have been fully considered but not rendered persuasive.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Prosecution of this application is closed by means of this final office action § 1.113, applicant may request continued examination of the application by filing a Request for Continued Examination of under 37 CFR § 1.114 and providing the corresponding fee set forth in § 1.17(e) for the submission of, but not limited to, new arguments, an information disclosure statement, an amendment to the written description, claims, drawings, or new evidence in support of patentability. Or applicant whose claims have been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences under 35 U.S.C. §134.

Pertinent Prior Art:

The following prior art was made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinence is presented in accordance with MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

Roop et. al. teaches a system/method for the transmission of programming information in a displayable data stream, including a memory to store said programming information, where said memory is repeatedly updated by said displayable data stream.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).


B. Prieto

TC 2100
Patent Examiner
December 27, 2003


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER